

REMARKS

Claims 1, 3, 4 and 8-14 are pending in the present application. Claims 1 and 8-14 are rejected. Claim 1 is herein amended. No new matter has been added. Applicants thank Examiner Gray for the courtesies extended in the telephone interview of December 2, 2011. Applicants' Statement of the Substance of the Interview is incorporated herein.

Applicants' Response to Claim Objections

Applicants herein revise the claims listing such that the claims previously indicated as claims 14 and 15 are now correctly listed as claims 13 and 14. Additionally, Applicants herein amend claim 1 to correct minor errors such as unnecessary commas. Favorable reconsideration is respectfully requested.

Applicants' Response to Drawings Objections

It is the position of the Office Action that the closed loop cut on the film having a width less than a width of said film must be illustrated in the figures or cancelled from the claims. As discussed in telephone interview of December 2, 2011, Applicants respectfully submit that this subject matter is clearly illustrated in at least original Figure 2, and discussed in paragraphs [0010], [0016], [0026] and [0027]. The term "closed loop cut" describes cuts of shapes including circles and ovals. It is noted that Applicants are free to be their own lexicographers. Favorable reconsideration is respectfully requested.

Applicants' Response to Claim Rejections under 35 U.S.C. §112

Claims 1 and 8-14 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Office Action indicates that the phrase a “closed loop cut on the film having a width less than a width of said film” appears to be new matter. However, as discussed in the telephone interview, Applicants respectfully submit that this subject matter is supported at least by Figure 2, as well as paragraphs [0010], [0016], [0026] and [0027]. As described above in the discussion of the drawings and the corresponding text, Figure 2 illustrates that the roller 13 includes a cutter blade 35B. As the roller 13 turns, the cutter blade 35B cuts the film FL of the strip material A, resulting in the cut L having a generally circular shape, with the dicing tape T formed therein. After the dicing tape T is removed, the base sheet S is exposed only in the generally circular portion within the cut L. Although the illustrated embodiment is a circular cut L, the cut L could also be other shapes, such as an oval, for example. Furthermore, as clearly illustrated, the total width of the cut L is less than the width of the film FL of the strip material A. The term “closed loop cut” describes cuts of shapes including circles and ovals.

Regarding the rejection under the first paragraph of §112, the test for determining compliance with the written description requirement in the first paragraph of § 112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. *In re Kalow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). In short, the claimed invention must somewhere be described in the original specification, although this does not mean that the claimed invention be

expressed *ipsis verbis* in order to satisfy the description requirement. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Applicants respectfully submit that even though the phrase “closed loop cut” is not expressed *ipsis verbis* in the specification, this subject matter is clearly supported by the specification and drawings as a whole. Therefore, Applicants respectfully submit that the phrase “closed loop cut on the film having a width less than a width of said film” is fully supported by the specification, and does not constitute new matter. Therefore, Applicants respectfully submit that the pending claims fully comply with the written description requirement. Favorable reconsideration is respectfully requested.

Applicants’ Response to Claim Rejections under 35 U.S.C. §103

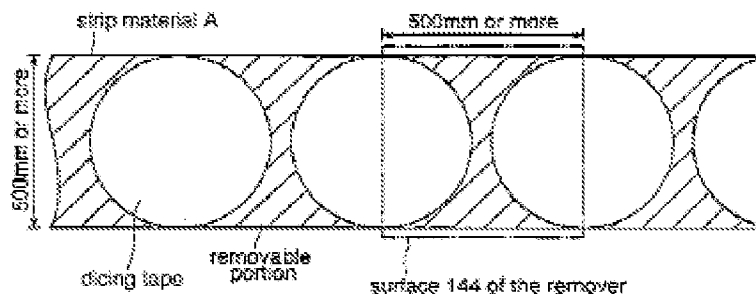
Claims 1 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhn (U.S. Patent No. 6,634,401) in view of Jeong et al. (U.S. Patent Application Publication No. 20040009650).

It is the position of the Office Action that Kuhn discloses the embodiment as claimed, with the exception of teaching that on the table, a ring shaped first adherend and a plate shaped second adherend are disposed, the second adherend being disposed inside of the first adherend or a pre-cutting device having a first member located on a film side of the strip material and a second member located on a base sheet side of the strip material, the first member having a blade which forms a closed loop cut on the film, said closed loop having a width less than a width of said film. The Office Action relies on Jeong to provide this teaching.

Kuhn is directed at a tape applicator and methods of applying tape to a surface. In Kuhn, tape is fed from a tape roller holder 102 to a cutter 122. The cutter 122 includes blades 126. After cutting, the tape is fed to platen 154 and application roller 152. As illustrated in Figure 4, Kuhn discloses that the tape is cut linearly. As discussed at column 10, line 38 to column 11, line 9, Kuhn explicitly discloses cutting in a V-shape.

Jeong is directed at a dicing tape attaching unit that can attach pre-cut dicing tape and general dicing tape to a wafer and an in-line system having the dicing tape attaching unit. Jeong discloses that a dicing tape 30 is first peeled by a peeling device 125, then pressed by a press roller 130 onto a wafer 150 and a ring frame 152. See Figure 7. Then, the dicing tape 30 is cut by a tape cutter portion 136 having a cutter 135, directly on the wafer 150 and the ring frame 152. As mentioned in paragraph [0055], Jeong discloses that dicing tape 30 is cut into a closed-loop form, after sticking dicing tape 30 into the back side of the wafer 150 and ring frame 152, using cutter 135. However, Jeong is nothing more than a conventional example as described in paragraph [0002] of the instant specification. Additionally, Applicants note that Figure 3 and 4 illustrate a circular pre-cut film, but this is an entire roll of pre-cut film that is prepared beforehand.

Applicants respectfully submit that the combination of Kuhn and Jeong does not disclose or suggest the embodiments as claimed. Kuhn discloses that a cut is necessarily formed on the adhesive sheet over the entire width of the tape (a direction perpendicular to the feeding direction of the tape). Even if the circular cutting of Jeong were combined with the pre-cutting of Kuhn, the result would be pre-cut dicing tape as in the drawing below:



This does configuration is not the configuration recited by the pending claims.

Additionally, Applicants note that the claimed embodiments require a pre-cutting device, a peeling device disposed downstream of the pre-cutting device, and a press roller downstream of the peeling device. In other words, the claims require that the structural elements are configured in a manner which allows the following sequence of events: Cut→Peel→Stick.

However, in Jeong, the cutter 135 is disposed downstream of the press roller 130 and the peeling device 125. In other words, Jeong discloses that the structural elements are configured in a manner which allows the following sequence of event: Peel→Stick→Cut. As such, the combination of cited art does not disclose or suggest the embodiments as claimed.

Additionally, as discussed in the telephone interview, Kuhn actually teaches away from any modification where the tape is cut in a loop shape. Kuhn teaches a V-shape cut, and there is no reason why one having ordinary skill in the art would modify this in order to be a circular cut. Therefore, for at least the above reasons, Applicants respectfully submit that the rejection is improper. Favorable reconsideration is respectfully requested.

Claims 8 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhn in view of Jeong, and further in view of Murphy (U.S. Patent No. 5,730,816).

It is the position of the Office Action that the combination of Kuhn and Jeong discloses the embodiments as claimed, with the exception of teaching that a tension control means comprises a dancer roller, which is movable vertically so as to allow the strip material to be fed out toward said press roller while giving tension due to its own weight to said strip material or first and second sensors for detecting a raised position and a lowered position of the dancer roller respectively. The Office Action relies on Murphy to provide this teaching.

In response, Applicants respectfully submit that claims 8 and 14 are patentable at least due to its indirect dependency on claim 1, which Applicants submit is patentable for at least the above reasons. Favorable reconsideration is respectfully requested.

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhn in view of Jeong, and further in view of Wesen (U.S. Patent No. 3,860,473).

It is the position of the Office Action that the combination of Kuhn and Jeong discloses the embodiments as claimed, with the exception of teaching that the pre-cutting means includes a die receiving plate and a die roller having a cutter blade formed on a roller. The Office Action relies on Wesen to provide this teaching.

In response, Applicants respectfully submit that claim 9 is patentable at least due to its indirect dependency on claim 1, which Applicants submit is patentable for at least the above reasons. Favorable reconsideration is respectfully requested.

Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhn in view of Jeong and Murphy, and further in view of Wesen (U.S. Patent No. 3,860,473).

It is the position of the Office Action that the combination of Kuhn, Jeong and Murphy discloses the embodiments as claimed, with the exception of teaching that the precutting means includes a die receiving plate and a die roller having a cutter blade formed on a roller. The Office Action relies on Wesen to provide this teaching.

In response, Applicants respectfully submit that claim 10 is patentable at least due to its indirect dependency on claim 1, which Applicants submit is patentable for at least the above reasons. Favorable reconsideration is respectfully requested.

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhn in view of Jeong, and further in view of Beaudry (U.S. Patent Application Publication No. 2003/0044481).

It is the position of the Office Action that the combination of Kuhn and Jeong discloses the embodiments as claimed, with the exception of teaching that the precutting means includes a movable roller and a die plate having a circular blade formed thereon. The Office Action relies on Beaudry to provide this teaching.

In response, Applicants respectfully submit that claim 11 is patentable at least due to its indirect dependency on claim 1, which Applicants submit is patentable for at least the above reasons. Favorable reconsideration is respectfully requested.

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kuhn in view of Jeong and Murphy, and further in view of Beaudry (U.S. Patent Application Publication No. 2003/0044481).

It is the position of the Office Action that the combination of Kuhn, Jeong and Murphy discloses the embodiments as claimed, with the exception of teaching that the precutting means includes a movable roller and a die plate having a circular blade formed thereon. The Office Action relies on Beaudry to provide this teaching.

In response, Applicants respectfully submit that claim 12 is patentable at least due to its indirect dependency on claim 1, which Applicants submit is patentable for at least the above reasons. Favorable reconsideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

If the Examiner deems that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

Application No. 10/574,847
Art Unit: 1745

Amendment
Attorney Docket No. 062289

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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